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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,437	05/04/2001	Tim W. Blair	2222.038000H	7818

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EXAMINER
PHAM, KHANH B

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/848,437	BLAIR ET AL.
	Examiner	Art Unit
	Khanh B. Pham	2167

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 September 2004</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-20</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-20</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/21/04</u>.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   The amendment filed September 9, 2004 has been entered. Claims 15 and 20

have been amended. Claims 1-20 are pending in this Office Action.

Claim Rejections - 35 USC § 102

2.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent
> granted on an application for patent by another filed in the United States before the invention by the
> applicant for patent, except that an international application filed under the treaty defined in section
> 351(a) shall have the effects for purposes of this subsection of an application filed in the United States
> only if the international application designated the United States and was published under Article 21(2)
> of such treaty in the English language.

3.   **Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by**

Unger et al. (US 5,721,910), hereinafter referred to as "Unger".

As per claim 1, Unger teaches a computer-implemented method of enabling a

user to organize and analyze information in electronic form, comprising the steps of:

- (1) "searching a first set of documents to thereby generate a second set of

   documents" at Col. 3 lines 9-17;

- (2) "automatically creating a first group comprising said second set of

   documents" at Col. 3 lines 9-17;

- (3) "analyzing said first group according to one or more analytical functions to thereby generate a third set of documents" at Col. 5 line 50 to Col. 6 line 15 ;

- (4) "automatically creating a second group comprising said third set of documents" at Col. 6 lines 5-15; and

- (5) "enabling selective iteration of at least one of steps (1)-(4)" at Col. 8 lines 50-62.

As per claim 2, Unger teaches the method of claim 1, further comprising the step of: "enabling the user to make at least one of said first group and said second group a permanent group" at Col. 3 lines 10-20.

As per claim 3, Unger teaches the method of claim 1, wherein "step (1) comprises the step of: performing a cluster analysis over said first set of documents to create a hierarchical arrangement of groups containing said first set of documents" at Col. 5 lines 15-50.

As per claim 4, Unger teaches the method of claim 1, further comprising the step of: "(i) performing a relevancy visualization analysis over at least one of said first group and said second group to identify how documents contained therein are inter-related with respect to key terms" at Figs. 10A-B.

As per claim 5, Unger teaches the method of claim 4, wherein "step (i) operates according to a rule book" at Col. 5 lines 15-50.

As per claim 6, Unger teaches the method of claim 5, wherein "said rule book comprises patent specific rules" at Col. 5 lines 15-50.

As per claim 7, Unger teaches the method of claim 1, further comprising the step of: "generating objects corresponding to process components of a work flow represented by at least steps (1)-(4)" at Col. 5 line 50 to Col. 6 line 20.

As per claim 8, Unger teaches the method of claim 7, wherein "step (i) comprises: generating said objects using object definitions" at Col. 8 lines 30-50.

As per claim 9, Unger teaches the method of claim 8, wherein "said object definitions comprise at least one of: a boolean operation object definition; a corporate family operating object definition; an export object definition; a folder object definition; an import object definition; a list exploder operation object definition; a list object definition; a query object definition; and a patent family dedupe object definition" at Col. 8 lines 30-50.

As per claim 10, Unger teaches the method of claim 7, further comprising the step of: "enabling a user to save one or more of said objects" at Col. 7 lines 25-40.

As per claim 11, Unger teaches the method of claim 7, further comprising: "enabling a user to re-execute said workflow by traversing said objects" at Col. 7 lines 25-40.

As per claim 12, Unger teaches the method of claim 7, further comprising: "enabling a user to create a new work flow by modifying said objects" at Col. 8 lines 50-65.

As per claim 13, Unger teaches the method of claim 1, further comprising the step of: "enabling a user to annotate at least one of said first group, said second group, and any portion of any document contained in said first group or said second group" at Col. 4 lines 47-57.

As per claim 14, Unger teaches the method of claim 1, wherein "said first set of documents is from at least one of a database, an external source, and over the Internet" at Col. 5 lines 3-6.

As per claim 15, Unger teaches a computer-implemented method of enabling a user to organize and analyze information in electronic form, comprising the steps of:

- (1) "searching members of a first set of documents to thereby generate a second set of documents" at Col. 3 lines 9-17;

- (2) "automatically creating a first group comprising said second set of documents" at Col. 3 lines 9-17;

- (3) "analyzing said first group according to one or more analytical functions executed with respect to information stored in an external database, distinct from said first and second sets of documents, to thereby generate a third set of documents" at Col. 5 lines 15-50 ;

- (4) "automatically creating a second group comprising said third set of documents" at Col. 6 lines 5-15; and

- (5) "enabling selective iteration of at least one of steps (1)-(4)" at Col. 8 lines 50-63.

As per claim 16, Unger teaches the method of claim 15, wherein "said external database comprises a bibliographic information database" at Col. 5 lines 15-50.

As per claim 17, Unger teaches the method of claim 15, wherein "said external database comprises a bibliographic information database" at Col. 4 lines 44-52.

As per claim 18, Unger teaches the method of claim 15, wherein "said external database comprises a group information database, said method further comprising defining a group membership information, and storing the group membership information in the group information database" at Col. 4 lines 44-53.

As per claim 19, Unger teaches the method of claim 15, wherein "said one or more analytical functions comprises a clustering analysis of documents within the second set of document" at Col. 5 lines 15-50.

As per claim 20, Unger teaches the method of claim 15, wherein "said one or more analytical functions comprises a user-interactive relevancy visualization tool for clustering analysis of document within the second set of documents" at Col. 8 lines 50-63 and Figs 2-4.

Response to Arguments

4.   Applicant's arguments filed September 9, 2004 have been fully considered but

they are not persuasive. The examiner respectfully traverses applicant's arguments.

Applicant argued at pages 8-12 that Unger does not teach or suggest: "enabling

selective iteration of at least one of steps (1)-(4). On the contrary, Applicant stated at

page 10 that Unger teaches: ""the **initial stages** of Unger's linear six stage process

may be **restarted** before progressing to the next stage." As seen in the rejection above,

Unger's initial stages correspond to at least one step (1)-(4) of claim 1, therefore,

Unger's enabling restarting the initial stages before progressing to the next stage is

similar to applicant's "enabling selective iteration of at least one of steps" as claimed.

Further, since applicant's specification does not provide definition for "iteration",

common meaning of the term has been used. Webster's New World Dictionary of

Computer Terms, 6th edition defines "**iteration**" as: "The **repetition** of a command or

program statement." This definition is also consistent with the examiner's interpretation

of the claim language as discussed above.

In response to applicant's argument that Unger reference fails to show certain

features of applicant's invention, it is noted that the features upon which applicant relies

(i.e., "the output of one stage of Unger cannot be arbitrarily applied as an input to

another stage of Unger", "Unger teaches or suggests only a linear method..." while

"applicants' claimed invention enables a non-linear technique of searching ...") are not

recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

5.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

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you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

                                        Khanh B. Pham
                                        Examiner
                                        Art Unit 2167

March 24, 2005
KBP

Primary Examiner